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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,167	10/25/2001	James M. Tibbitt	37,270	3418

4249 7590 10/01/2003

CAROL WILSON
BP AMERICA INC.
MAIL CODE 5 EAST
4101 WINFIELD ROAD
WARRENVILLE, IL 60555

EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,167

Applicant(s)

TIBBITT ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-12, 13/11, 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-4, 13/1, 14-15 is/are rejected.
- 7) ☒ Claim(s) 5-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other:

DETAILED ACTION

1. Claim 16 has been cancelled.

Inventorship

2. In view of the papers filed 6/18/2003, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of Paul J. Cahill.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 103

3. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as ROTTER ET AL (US 6,406,766) at the time this invention was made. Accordingly, ROTTER ET AL '766 is disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application.
4. Claims 1-4, 13/1, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over SPEER ET AL (US 5,350,622 or US 5,700,554).

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SPEER ET AL '622 and '554 each disclose a transparent oxygen scavenging composition suitable for forming single-layer packaging materials for oxygen sensitive materials, wherein the composition comprises up to an oxygen-scavenging polybutadiene (co)polymer, up to 99 wt% polymeric diluent such as PET, and a transition metal catalyst, wherein the single layer material may be further coated (SPEER ET AL '662, lines 23-68, col. 4; lines 15-60, col. 5; line 65, col. 5 to line 13, col. 6; line 40-45, col. 6; lines 8-10, 15-16, col. 7) (see corresponding portions of SPEER '554) as recited in claims 1-4, 13/11, 14.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the compositions disclosed in SPEER ET AL '622 and '554 in single layer packaging materials in order to simplify manufacture and recycling. One of ordinary skill in the art would have selected the type and relative amounts of the bulk polymeric component, oxygen-scavenging copolymer and additives to obtain the specific transparency and optical properties (claim 1) desired for a specific application. Since the disclosed material composition may contain a high percentage of polyester with relatively minor amounts of the oxygen-scavenging component, one of ordinary skill in the art would reasonably believe that the disclosed packaging materials is capable of being recycled with other polyester materials (claim 15).

Response to Arguments

5. Applicant's arguments filed 6/18/2003 have been fully considered but they are not persuasive.

(A) Applicant argues that SPEER ET AL '622 and '554 fail to specifically teach and disclose monolayer packaging materials. However, the references' discussion of multilayer

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packaging materials does not constitute a teaching-away from monolayer films in view of the references' clear and explicit statement that the disclosed polymeric materials can be used in single-layer form, as admitted by Applicant. Applicant has not provided any probative evidence of criticality or unexpected results from the claimed monolayer films.

(B) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., materials suitable for direct food contact) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The present claims merely recites oxygen-sensitive products, and the references clearly indicate that the disclosed packaging materials are suitable for packaging oxygen-sensitive articles, which would reasonably imply that the disclosed single-layer packaging material is suitable for contact with at least certain types of oxygen-sensitive articles. Applicant has not provided any persuasive evidence to the contrary.

(C) Applicant argues that the SPEER ET AL references fails to disclose materials which met the recited haze limitations. However, since the references clearly characterize the disclosed polymeric compositions as "transparent" (SPEER ET AL '622, line 15, col. 5), one of ordinary skill in the art would reasonably believe that said compositions to have low haze values. Applicant has not provided any probative evidence of criticality in the recited haze values, nor has Applicant provided probative evidence to indicate that the compositions of SPEER ET AL are incapable of producing films with the recited haze values.

Allowable Subject Matter

6. Claims 11-12, 13/11, 17-19, 20 are allowed.
7. Claims 5-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose or suggest a monolayer package comprising an oxygen scavenging composition and having the following features: (a) wherein the oxygen-scavenging composition comprises the recited copolymer with the specified polycondensate and oxygen-scavenging segments (claims 5, 20); and/or wherein the oxygen scavenging composition has the recited migration level (claims 10, 11, 20).

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

September 16, 2003



Vivian Chen
Primary Examiner
Art Unit 1773